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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,548	02/08/2002	Kevin Trilli	21190-06329	9887
758	7590	05/24/2006	EXAMINER	
FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			SZYMANSKI, THOMAS M	
			ART UNIT	PAPER NUMBER
			2134	

DATE MAILED: 05/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/071,548	TRILLI ET AL.	
	Examiner	Art Unit	
	Thomas Szymanski	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-26 have been examined.

Specification

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Verisign Digital ID (hereinafter "VID"), and further in view of Verisign Authentication Services (hereinafter "VAS"). The Verisign Digital ID (VID) reference is composed of Verisign Secure Site (directoneusa.com, caixadirecta.cgd.pt) (hereinafter "VSS"), Client Enrollment (hereinafter "Client"), ISP Enrollment Help (hereinafter "ISP"), and Server Faq (hereinafter "FAQ"). All of the above cited VID references are related documents from the Verisign Digital ID website recovered from web.archive.org from at least one year prior to the earliest effective filing date of the applicant.
5. VID teaches a system for providing security to web hosts via a certificate system.

Art Unit: 2134

6. VID fails to explicitly teach using one server ID for multiple virtual hosts, wherein the ISP is authorized to individualize the certificate ID for each of the hosted merchants. However, in related art VAS teaches a system for a shared hosting service, wherein one server ID is used per server for all communications for merchant customers virtual hosting on a server that is individualized per merchant.

7. Security and accountability for data is of the highest importance when conducting transactions online. The trust of the user is a paramount concern and the ability to properly identify the source of data and the fact that such a source is secure and trustworthy is a desirable effect to be able to provide (VAS lines 8-13, VSS entire document, ISP page 5, FAQ pg 1).

8. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to combine the Verisign Digital ID reference with VAS for the advantages of increased security and perceptibility to the user. The combination of these two references consists of VID server IDs altered to allow specific IDs for each hosted site on a single server while realizing the advantages of security and simple enrollment processes as disclosed.

9. Regarding Claims 1 and 7: Service provider containing a plurality of entity sites (Verisign Authentication Services lines 2-5)

Conglomerated certificate provided by a third party (Verisign Authentication Services lines 2-5, ISP pg 1-2, FAQ pg 1-2, VSS) As provided within the combination the Global Server ID may be individualized as recited by VAS for each merchant.

Art Unit: 2134

Means for entity to convert conglomerated certificate to individual certificate for the entities site (Verisign Authentication Services lines 2-6, ISP pg 1-5, FAQ 1-6, Client pg

1) As it can be seen from the provided documents there are means for allowing an entity to apply for and receive certificates.

10. Regarding Claims 2, 8, 9, and 11 : Plurality of conversion tokens pre-purchased from trusted third party by the ISP (Verisign Authentication Services lines 5-10, ISP pg 1-5, FAQ 1-6, Client pg 1) The pre-purchase is comprised of means for the dissemination of such rights to the client as such there is a tool that must provide a code for proper allowance of activation and further to disallow usage beyond that which is normally granted thereby decrementing the rights of that code after initial allowance of use. As stated within the VID reference entities must apply and be approved for an ID as well as purchase those rights before such an ID can be used.

11. Regarding Claims 3, 5, 19, and 22: seal evidencing the entity site's authentication displayed on client computer; at least one entity's site has received an individualized certification (Verisign Authentication Services lines 3-6, VSS) a seal is representative of a plug-in-module as the seal must be downloaded and plugged into the browser for purposes of display. As the combination dictates each given entity of a server may have an individual certificate.

12. Regarding Claims 4, 6, 20, 21, 23, and 24: clicking/activating the seal results in authentication information being displayed (Verisign Authentication Services lines 5-10, VSS) As stated when the seal is activated it displays the provided splash page as defined. Additionally, as stated previously a seal is representative of a plug-in-module

Art Unit: 2134

as it provides for the exact same functionality of displaying authentication evidence and activation upon clicking by the user.

13. Regarding Claim 10: Service provider making available an activation tool; the entity presenting the tool to the trusted third party, thereby petitioning the trusted third party to convert the conglomerated authenticity certification into an individualized authenticity certification (VSS, FAQ 1-6, ISP 1-5) As recited by VID all relevant information such as server id company information technical contacts must be provided, This information identifies an ISP and therefore any existing ID's for which such a request inherently petitions for an individualized certificate and means for activation as disclosed on ISP pg 5.

14. Regarding Claims 12 and 18: The activation tool comprises a digital activation code; the activation tool is a digital token, and the trusted third party decrements a token counter (ISP pg 1-5, FAQ 4-6) The manner by which the combination performs activation is by a pin process and email notification allowing for a token (installation) to be sent to the entity once approved and redeemed when installed. Each token being inherently usable once.

15. Regarding Claims 13, 14, 15, 16, and 17: Tool appended to URL of a computer, domain name presented to third party, domain name used to access whois database, proof of right database accessed based upon provided information (VSS, FAQ 1-6, ISP 1-5) As defined by the provided document the domain name is authenticated via the prescribed investigation that is inclusive of all that is stated above, the stated investigation as provided for and the specified tool must be appended in a manner

Art Unit: 2134

consistent with attachment with the URL of the participant computers. As it can be seen from the ISP enrollment and VSS a whois is performed based on the provided information.

16. Claims 25 and 26 are computer readable medium implementations of claims 1-

24. As such claims 25 and 26 are rejected on the same basis.

Response to Arguments

17. Applicant's arguments with respect to claims 1-26 have been considered but are moot in view of the new ground(s) of rejection.

18. The applicant has argued that the VAS reference as presented is inoperative and thus does not qualify as prior art. The examiner respectfully disagrees with such an assertion and provides the following:

19. When the reference relied on expressly anticipates or makes obvious all of the elements of the claimed invention, the reference is presumed to be operable. Once such a reference is found, the burden is on applicant to provide facts rebutting the presumption of operability. In re Sasse, 629 F.2d 675, 207 USPQ 107 (CCPA 1980). See also MPEP § 716.07.

20. MPEP 2121.01 [R-3] states: "In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention not novel' or anticipated' within section 102, the stated test is whether a reference contains an enabling disclosure'... ." In re Hoeksema, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). The disclosure in an assuredly anticipating reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it

Art Unit: 2134

cannot be produced without undue experimentation. *Elan Pharm., Inc. v. Mayo Found. For Med. Educ. & Research*, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003) (At issue was whether a prior art reference enabled one of ordinary skill in the art to produce Elan's claimed transgenic mouse without undue experimentation. Without a disclosure enabling one skilled in the art to produce a transgenic mouse without undue experimentation, the reference would not be applicable as prior art.). A reference contains an "enabling disclosure" if the public was in possession of the claimed invention before the date of invention. "Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his [or her] own knowledge to make the claimed invention." *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985).

21. It is clear from the above description of an "enabling disclosure" that given the recitation of the VAS reference one of ordinary skill in the art could have combined the publications description of the invention with their own knowledge to make the claimed invention, thus providing for the VAS reference to be viable as prior art.

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of art disclosed by the references cited and the objections made. Applicant must show how the amendments avoid such references and objections. See 37 CFR 1.111(c).

Art Unit: 2134

23. Inquiries concerning this communication or earlier communications from the examiner should be directed to Thomas M. Szymanski who can be reached at (571) 272-8574. The examiner's normal working schedule is between the hours 8:00am – 4:30pm (EST), Monday – Friday.

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse, can be reached at (571) 272-3838. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thomas M. Szymanski
THOMAS M. SZYMANSKI
PRIMARY EXAMINER